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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451

Baxley

Mailed: March 17, 2010

Cancellation No. 92048825

Key West Innkeeper's
Association, Inc.

v.

The Popular House, Inc.

Before Hairston, Cataldo, and Bergsman,
Administrative Trademark Judges.

By the Board:

Registration No. 2946931 on the Supplemental Register for the mark KEY WEST BED AND BREAKFAST in typed form for "rental of guest rooms featuring breakfast, namely, bed and breakfast services" in International Class 43 was issued on May 3, 2005 to "Key West Bed and Breakfast," a Florida corporation ("Key West"). Registration No. 3114306 on the Principal Register for the same mark in standard character form for the same services in the same international class was issued on February 4, 2008 to The Popular House, Inc., also a Florida corporation ("Popular"). Both registrations include a disclaimer of BED AND BREAKFAST. Registration No. 3114306 includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f). The record herein indicates that Key West and Popular refer to

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the same entity. Accordingly, we also refer to Key West/Popular as "respondent."

Key West Innkeeper's Association, Inc. ("petitioner") filed a petition to cancel both registrations on the ground of genericness. Petitioner also seeks to cancel Registration No. 2946931 on the grounds that, because "there has never been a Florida corporation known as 'Carlson,Jody,E,' or 'Key West Bed and Breakfast,' ... neither Jody E. Carlson nor Key West Bed [and] Breakfast is the owner of [that registration] and had no rights to take action on the application [therefor]." Respondent denied the salient allegations of the petition to cancel in its answer and asserted affirmative defenses.

This case now comes up for consideration of: (1) petitioner's motion (filed June 9, 2009) for summary judgment on the grounds that: (a) the application for Registration No. 2946931 was void *ab initio* because neither "Carlson,Jody,E" nor Key West Bed And Breakfast could properly take action in obtaining that registration; (b) the involved KEY WEST BED AND BREAKFAST mark is generic; and (c) the involved KEY WEST BED AND BREAKFAST mark is primarily geographically descriptive and has not acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f); (2) respondent's motion (filed July 17, 2009) to correct name of the registrant in Registration No.

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2946931;¹ (3) respondent's cross-motion (filed August 24, 2009) for summary judgment on the same grounds upon which petitioner seeks entry of summary judgment that respondent incorporated into its brief in opposition to petitioner's motion for summary judgment; (4) petitioner's motion (filed September 28, 2009) to strike Internet evidence from respondent's combined brief in opposition to petitioner's motion for summary judgment and cross-motion for summary judgment, which was incorporated into petitioner's combined reply brief in support of its motion for summary judgment and brief in opposition to respondent's cross-motion for summary judgment; and (5) respondent's motion (filed October 19, 2009) to strike petitioner's combined reply brief in

¹ Concurrently with the motion to correct Registration No. 2946931, respondent filed a combined brief in opposition to petitioner's motion for summary judgment and cross-motion for summary judgment and a separate motion to strike certain exhibits from petitioner's motion for summary judgment. On August 6, 2009, petitioner filed a motion to strike respondent's combined brief in opposition to petitioner's motion for summary judgment and cross-motion for summary judgment, alleging that such a combined brief and cross-motion was somehow procedurally improper.

Following a telephone conference between the parties' attorneys and the Board attorney assigned to this case, the Board, in an August 12, 2009 order, denied petitioner's motion to strike. However, the Board noted in that order that, because respondent's motion to strike presents procedural arguments in opposition to petitioner's motion for summary judgment, it is actually a supplemental brief in opposition to petitioner's motion for summary judgment, which is expressly prohibited by Trademark Rule 2.127(e)(1), and that, taken together, respondent's motion to strike and combined brief in opposition and cross-motion exceed the twenty-five page limit for briefs in support of, or in opposition to, motions in Board proceedings. The Board allowed respondent time in which to file a revised combined brief in opposition and cross-motion and reset remaining briefing dates in connection with the pending motions.

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support of its motion for summary judgment and brief in opposition to respondent's cross-motion for summary judgment. The motions have been fully briefed.

The Board turns first to respondent's motion to strike petitioner's combined reply brief in support of its motion for summary judgment and brief in opposition to respondent's cross-motion for summary judgment, which is based in part on the untimely filing of that brief.² Under the Board's August 12, 2009 order, petitioner was allowed until thirty-five days from the *date of service* of respondent's renewed combined brief in opposition and cross-motion to file a combined reply brief in support of its motion for summary judgment and brief in opposition to respondent's cross-motion for summary judgment. Because respondent served its renewed combined brief on August 21, 2009, petitioner's combined brief was due by not later than September 25, 2009. In response to the motion to strike, petitioner acknowledges

² Respondent also incorrectly asserts that striking petitioner's combined brief is warranted because petitioner has improperly relied upon unpublished decisions in support of arguments presented therein. Parties can cite to unpublished decisions in Board proceedings for whatever persuasive value those unpublished decisions might have; the Board, however, is not bound by unpublished decisions. See *Citation of Opinions to the Trademark Trial and Appeal Board*, Official Gazette, January 23, 2007. Moreover, the Board generally will not grant a motion to strike a brief, or any portion thereof, simply because a party objects to the contents of its adversary's brief. Rather, any objections which an adverse party may have to the contents of such a brief will be considered by the Board in its determination of the original motion, and any portions of the brief that are found by the Board to be improper will be disregarded. See TBMP Section 517.

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that it filed its combined brief late on September 28, 2009 and asserts that such late filing was caused by its attorney's erroneous docketing of the due date for that combined brief as September 28, 2009, i.e., thirty five days from the *filing date* of respondents' renewed combined brief.

Because petitioner did not timely file its combined brief, petitioner must establish that its untimeliness was the result of excusable neglect. *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380 (1993); *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997); Fed. R. Civ. P. 6(b)(1). An attorney's docketing error is considered wholly within that attorney's control and thus does not generally constitute excusable neglect. See *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000); TBMP Section 509.01.

Accordingly, respondent's motion to strike is granted. Petitioner's combined reply brief in support of its motion for summary judgment and brief in opposition to respondent's cross-motion for summary judgment is hereby stricken as untimely. Because we have not considered petitioner's combined brief, we also have not considered respondent's reply brief in support of its cross-motion for summary judgment.

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We will decide the cross-motions for summary judgment based on petitioner's motion for summary judgment and respondent's combined brief in response to petitioner's motion for summary judgment and cross-motion for summary judgment. Although we have not considered petitioner's combined reply brief in support of its motion for summary judgment and brief in response to respondent's cross-motion, the late filing of petitioner's combined brief clearly indicates that petitioner does not concede the merits of respondents' cross-motion for summary judgment. Accordingly, we will decide both cross-motions for summary judgment on the merits.

Regarding respondent's motion to strike printouts of excerpts for Internet websites that were not supported in petitioner's brief in support of its motion for summary judgment by a declaration, the Board will consider at final hearing a printout of an excerpt from an Internet website that is submitted under notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e), where that printout identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL). See *Safer, Inc. v. OMS Investments, Inc.*, ___ USPQ2d ___ (TTAB, Opposition No. 91176445, February 23, 2010). In deciding motions for summary judgment, the Board considers printed

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publications that are submitted as exhibits to briefs in connection therewith without requiring a notice of reliance. See TBMP Section 528.05(a) (2d ed. rev. 2004). Accordingly, the motion to strike is denied to the extent that the Board has considered petitioner's printouts of excerpts from Internet websites that include both the date on which those excerpts were accessed and printed and the URL of the websites at issue, but has not considered those printouts that do not include both access dates and sources.

The Board will now consider the parties' cross-motions for summary judgment on the pleaded ground that Registration No. 2946931 is void *ab initio* because neither "Carlson, Jody, E" nor Key West Bed And Breakfast could properly take action in obtaining that registration.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). In considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the nonmovant, in this case opposer, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

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The USPTO file for Registration No. 2946931 indicates that the application for that registration was filed by "Carlson, Jody, E," a Florida corporation, and that, during *ex parte* examination of the application, applicant amended its identity to "Key West Bed and Breakfast, a Florida corporation."³ The parties do not dispute that there is no Florida corporation named "Carlson, Jody, E" (or Jody E. Carlson) or Key West Bed and Breakfast.⁴

If an application is filed in the name of a non-existent entity or under an applicant's trade name, the application may be amended to correctly identify the applicant. See TMEP Sections 1201.02(c)(1) and 1201.02(c)(7). The evidence that applicant submitted during *ex parte* prosecution of its application for Registration No. 2946931 establishes that there is no genuine issue of material fact that there is no Florida corporation named

³ Petitioner asserts in support of its motion for summary judgment that Key West's president, Jody E. Carlson, filed the application for that registration as an individual. However, the application indicates that this assertion is incorrect.

⁴ The circumstances in this case are distinguished from *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988), upon which petitioner relies in support of its claim that the application for Registration No. 2946931 is void *ab initio*. In *Huang*, the application at issue was filed by the mark owner's president as an individual, two days after ownership of that had transferred to a newly formed corporation. Here, the application was filed by a non-existent Florida corporation that has the same name as Key West's president. Because the identification of the applicant as a corporation with the same name as the applicant's president created an inconsistency, allowance of the amendment to correct this inconsistency was appropriate. See TMEP Section 1201.02(c)(3).

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"Carlson, Jody, E" (or Jody E. Carlson) and that Key West Bed and Breakfast is a fictitious name for Popular, which is registered with the Secretary of State of the State of Florida under which Popular does business. Accordingly, notwithstanding that such application was filed by a non-existent entity that has the same name as Popular's president and that the identity of that applicant was then amended to the proper applicant's trade name, i.e., another non-existent entity, there is no genuine issue of material fact that the application for Registration No. 2946931 is not void *ab initio* and that the applicant was merely misidentified in that application. Accordingly, respondent's cross-motion for partial summary judgment on this ground is granted, and petitioner's motion for summary judgment on this ground is denied.

Further, in view of the foregoing, amendment of the name of the registrant to The Popular House, Inc., is appropriate.⁵ Accordingly, respondent's motion to correct Registration No. 2946931 is granted.⁶

⁵ Indeed, based on the evidence that was submitted during *ex parte* prosecution of the application for Registration No. 2946931, the identity of the applicant for that registration could have, and at least arguably should have, been amended to The Popular House, Inc., during *ex parte* prosecution of that application.

⁶ The USPTO's Post-Registration division issued a corrected Registration No. 2946931 on February 26, 2010.

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The Board now turns to the parties' cross-motions for summary judgment on the petitioner's pleaded genericness claim. There are two steps in determining whether a mark is generic: (1) What is the genus of goods or services at issue? and (2) Is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services? See *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

After reviewing the parties' arguments and evidence, we find that disposition of this proceeding by summary judgment is inappropriate. In particular, we find that, at a minimum, there is a genuine issue of material fact as to whether the term KEY WEST BED AND BREAKFAST is understood by the relevant public to refer primarily to the services at issue, i.e., "rental of guest rooms featuring breakfast, namely, bed and breakfast services," or as a source identifier for respondent's services. During her discovery deposition, respondent's president agreed that "the phrase Key West bed and breakfast describes what services are offered by [certain competitors] as of 2005." Carlson deposition at 127. Respondent's president further stated that the wording "Key West bed and breakfasts," in the plural, "describes a number of guest houses." *Id.* at 129. Nonetheless, these statements do not, by themselves,

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establish public understanding of the wording KEY WEST BED AND BREAKFAST as a generic term. Petitioner, on its part, relies heavily upon the separate definitions of the terms "Key West" and "bed and breakfast" in support of its genericness claim. However, to prevail at trial, petitioner must establish the genericness of the phrase "Key West Bed and Breakfast" as a whole and not as a combination of the separate phrases "Key West" and "bed and breakfast." See *In re American Fertility Society*, 51 USPQ2d 1832 (Fed. Cir. 1999). Accordingly, petitioner's motion for summary judgment and respondent's cross-motion for summary judgment on petitioner's pleaded genericness claim are both denied.

Regarding the parties' cross-motions for summary judgment on the ground that Registration No. 3114306 should be cancelled because the wording KEY WEST BED AND BREAKFAST is primarily geographically descriptive under Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052(e)(2), and has not acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), petitioner did not plead this ground in the petition to cancel.⁷ A party cannot obtain

⁷ A genericness claim differs from one that a term has not acquired distinctiveness. Generic terms are wholly unregistrable on either the Principal or Supplemental Registers, whereas descriptive terms that are not inherently distinctive and have not acquired distinctiveness may be registrable on the Supplemental Register. See *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649 (TTAB 2005); *In re Dial A Mattress Operating Corp.*, 52 USPQ2d 1910 (TTAB 1999).

In paragraph 16 of the petition to cancel, petitioner alleges that "[t]he phrase 'Key West bed and breakfast' is generic and

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summary judgment on an unpleaded claim. See TBMP Section 528.07(a). Accordingly, the parties' cross-motions for summary judgment on that ground are denied.

The parties' excessive motion practice in connection with the cross-motions for summary judgment has not gone unnoticed. The parties are strongly urged to refrain from further excessive motion practice herein and to move this case forward to trial without undue delay.

Proceedings herein are resumed. Remaining dates herein are reset as follows.⁸

Plaintiff's 30-day Trial Period Ends	5/15/10
Defendant's Pretrial Disclosures	5/30/10
Defendant's 30-day Trial Period Ends	7/14/10

incapable of functioning as a registrable trademark denoting source, and as such, cannot be registered on the Principal Register (even under 15 U.S.C. [Section] 1052(f)) or on the Supplemental Register." This allegation sets forth a claim of genericness only and does not set forth both claims of genericness and lack of acquired distinctiveness.

Although the parties both argued the issue of whether the involved wording has acquired distinctiveness, the Board, in deciding motions for summary judgment, generally does not add issues argued by the express or implied consent of the parties, as it does at final hearing. See Fed. R. Civ. P. 15(b); TBMP Section 507.03.

In addition, because Registration No. 3114306 was issued under Trademark Act Section 2(f), "the statute accepts a lack of inherent distinctiveness as an established fact." See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Further, regarding Registration No. 2946931, registration on the Supplemental Register may be deemed an admission that the subject matter for which registration is sought is not inherently distinctive. See *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1137 n.11 (TTAB 1992). Accordingly, any assertion that the wording KEY WEST BED AND BREAKFAST is primarily geographically descriptive is not properly raised in this proceeding.

⁸ Petitioner's pretrial disclosures were due on May 26, 2009, prior to the filing of its motion for summary judgment.

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Plaintiff's Rebuttal Disclosures	7/29/10
Plaintiff's 15-day Rebuttal Period Ends	8/28/10

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.